The Examiner rejects claims 1 and 2 under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,891,133 to *Murphy-Chutorian* in view of U.S. Patent No. 5,840,059 to *March et al.*

Claim 1 of the subject application is directed to a percutaneous myocardial revascularization marking and therapeutic or diagnostic agent delivery system comprising: a treatment catheter having a proximal end interconnected with a source of tissue ablative energy and a distal end for applying that energy to the heart wall to create a channel therein, and a channel marking and drug delivery catheter subsystem connected to an imaging medium source and a source of a therapeutic or diagnostic agent and having a distal end proximate the distal end of the treatment catheter for applying both an imaging medium and the therapeutic or diagnostic agent in or proximate the channel.

Murphy-Chutorian does not disclose "a channel marking and drug delivery catheter subsystem connected to an imaging medium source and a source of a therapeutic or diagnostic agent and having a distal end proximate the distal end of the treatment catheter for applying both an imaging medium and the therapeutic or diagnostic agent in or proximate the channel" as claimed by the applicant. The Examiner acknowledges in the Office Action that *Murphy-Chutorian* fails to disclose this feature. However, the Examiner states that *Murphy-Chutorian* teaches the advantages of drug therapy for the treatment of occlusive coronary artery, and that March et al. discloses the potential benefits of therapeutic agents for the treatment.

With regard to obviousness, the law is clear that:

> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed

> invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital System, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Murphy-Chutorian does not disclose, teach, or suggest a channel marking and drug delivery catheter subsystem as claimed by the applicant. Although *Murphy-Chutorian* does discuss drug therapy for the treatment of coronary artery blockage, this discussion occurs in the Background section in a discussion of modern treatments which are inferior to the invention of *Murphy-Chutorian*. Drug therapy is only discussed to show that there are drawbacks to drug therapy that the invention of *Murphy-Chutorian* overcomes. The mere mention of drug therapy in *Murphy-Chutorian* is not a teaching or suggestion to include drug therapy in the invention of *Murphy-Chutorian*.

There is no teaching or suggestion *Murphy-Chutorian* to include a drug delivery catheter subsystem for applying a therapeutic agent as claimed by the applicant. Accordingly, applicant submits that claims 1 and 2 are not unpatentable over the cited references.

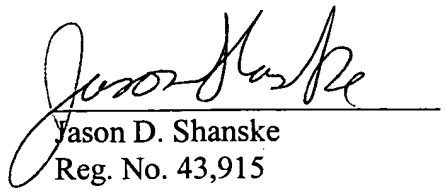
The Examiner also rejects claims 3 under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,891,133 to *Murphy-Chutorian* and U.S. Patent No. 5,840,059 to *March* as applied to claims 1 and 2 above, and further in view of U.S. Patent No. 5,725,523 to *Mueller*. For the reasons set forth above, applicant submits that claim 3 is not unpatentable over the cited references.

Each of the Examiner's rejections has been addressed or traversed. Accordingly, it is respectfully submitted that the application is in condition for allowance. Early and

favorable action is respectfully requested.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned or his associates, collect in Waltham, Massachusetts, (781)890-5678.

Respectfully submitted,



Jason D. Shanske
Reg. No. 43,915